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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/054,597 04/03/98 POSEGGA

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WM02/1206

EXAMINER

ESCALANTE, D

ART UNIT

PAPER NUMBER

2645

DATE MAILED:

12/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/054,597

Applicant(s)

POSEGGA, JOACHIM

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 20 October 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) ☐ Other: _____

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
2. The corrected or substitute drawings were received on October 20, 2000. These drawings are approved.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 9, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “the device” in line 2. There is insufficient antecedent basis for this limitation in the claim. Claims 2 – 9 are rejected because they depend on a rejected claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 5, 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Moss et al. U.S. Patent 5,485,370 (hereinafter Moss), newly cited.

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Regarding claim 1, Moss discloses of an apparatus made available in a telecommunications network. The apparatus comprises of a least one-network server (60) having a user interface program. See col. 18 lines 33 – 41. A user-side terminal (1,19 – Fig. 10), the user side terminal being capable of connection to the at least one network server. See Fig. 10. A control and operating device (19) executing a user interface to control and operate the service. See col. 18 lines 33 – 41, lines 54 – 60. The control and operating device is assigned to the user-side terminal (telephone-computer) and the at least one network server transmits (downloads) the user interface program to the control and operating device before service is used. See col. 3 lines 48 – 53 and col. 12 lines 45 – 61.

Regarding claim 2, the user side terminal includes a telephone (1). See Fig. 1.

Regarding claim 5, Moss as applied to claim 2 teach of the microphone in the telephone being used for inputting speech and the control and operating device is used for displaying text. See col. 4 lines 44 – 46, 60 – 62.

Regarding claim 7, the control and operating device includes a computer (19). See Fig. 1.

Regarding claim 10, Moss discloses of a method wherein at least one network server stores at least one user interface program. See col. 18 lines 21 – 41. The at least one user interface program providing operating functionality which comprises of using a user-side control and operating device (19) to request the at least one user interface program to be transmitted from the at least one network server to the control and operating device before the service is used. See col. 3 lines 48 – 53 and col. 12 lines 45 – 61. The method further includes executing

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the user interface program by the control and operating device, so that an operator can control and operate the service through a user interface. See col. 5 lines 7 – 38.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 3, 4, 6, 8, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss in view of Dekelbaum et al. U.S. Patent 5,838,682, newly cited.

Regarding claims 3, Moss as applied to claim 1 does not expressly teach of the service including a speech recognition system. Dekelbaum et al. teach of a system, as applied to claim 1, which comprises of a speech recognition system. See col. 14 lines 34 – 48. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using speech recognition in the system as taught by Dekelbaum so that the system can be used to display speech in the form of text to the terminal.

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Regarding claim 4, Moss as applied to claim 1 does not expressly teach of the apparatus further comprising an ISDN line connected to the at least one network server. Dekelbaum et al. teach of an ISDN and the first channel of the ISDN line being assigned to the user side terminal and a second channel of the ISDN line being assigned to the control and operating device. See col. 6 lines 39 – 62, col. 14 lines 49 – 67. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using an ISDN connection as taught by Dekelbaum so that there can be a faster connection and data speed.

Regarding claims 6, 8, 9 and 11, Moss as applied above of the does not expressly teach control and operating device or the terminal including a JAVA processor or a JAVA execution-time environment, however, the system of Moss does send applications to the user. See Fig. 14. Dekelbaum et al. teach of using JAVA in the system. See col. 12 lines 22 – 36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using JAVA so that programs can be left on web pages which will allow the programs to be downloaded over the Internet.

Regarding claim 12, Moss as applied to claim 11, does not expressly teach of the service provides processing of speech into text. Dekelbaum et al teach of speech-to-text conversion and the display of the text being carried out using the control and operating device and conversion of speech into text being carried out by the at least one network server. See col. 14 lines 32 – 48. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by converting speech into text as taught by Dekelbaum so that the system can display to the operator what the user is saying in text form.

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Response to Arguments

10. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Huang U.S. Patent 6,052,456. Graphical Shelf Navigator for a Telecommunications Switch Management System.

Hillson et al. U.S. Patent 6,118,860. Public Communications Services Vending Method and Apparatus.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 308-6306 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 7:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 308-6306 or (703) 308-6296.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Ovidio Escalante
Examiner
Group 2645
December 4, 2000

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

